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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,413	09/10/2003	Peter Kite	13317.1001cip	4621

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EXAMINER

KANTAMNENI, SHOBHA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/659,413

Applicant(s)

KITE ET AL.

Examiner

Shobha Kantamneni

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Page 2. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: NONE.
Claim(s) rejected: 32,34,37,39-42,44-47,55 and 56.
Claim(s) withdrawn from consideration: NONE.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Page 2.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


SHAOJIA A. JIANG, PH.D.
PRIMARY EXAMINER

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PRIMARY EXAMINER

Applicant's proposed amended claims herein, change limitations and scope of claims, inserting new limitations into the independent claim 32, present new issue for search and consideration by the Examiner.
Therefore, the proposed amendment After Final will not be entered.

The rejection of Claims 32, 34, 37, 39, 40-42, 44-47, and 56 under 35 U.S.C. 112, second paragraph, as being vague for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is MAINTAINED.

The rejection of the Claims 32, 34, 37, 40, 41, 42, 45, 54-56 under 35 U.S.C. 102(b) as being anticipated by Kurginski (GB 1 279 148) is MAINTAINED for reasons as discussed in the Final Office Action mailed 04/12/2005, and those found below.

Applicant argues "Kurginski is not directed to and would not be perceived by one of ordinary skill in the art as teaching the removal or reduction of microbial growth per se.....Kurginski composition does not have a germicidal or bactericidal effect and one of ordinary skill in the art would not look to the compositions of Kurginski to provide a bactericidal effect in any application or setting." This argument is not persuasive. Examiner would like to point out that 1) since Kurginski discloses the same EDTA composition as that recited in the instant invention, the composition would possess the bactericidal effect over a broad range of microbes, and 2) Kurginski also discloses that a combination of solvent and EDTA solubilizes and removes gelatinous microorganisms. See page 2, lines 5-10. Thus Kurginski teaches removal or reduction of microorganisms.

The rejection of Claims 39, 44, 46 under 35 U.S.C. 103(a) as being unpatentable over Kurginski (GB 1 279 148) as applied to claims 32, 34, 37, 40, 41, 42, 45, 54-56 above, in view of Remington's Pharmaceutical Sciences is MAINTAINED.

Applicant argues that "Kurginski and Remington's Pharmaceutical Sciences are not properly combinable under 35 U.S.C 103 because they are non-analogous prior art references." This argument is not persuasive. Examiner would like to respectfully point out that the Applicants claims are directed to a composition, and it is obvious to a person of ordinary skill in the art at the time the invention was made to store the compositions in a sterile condition and administer using prefilled syringes as taught by Remington Pharmaceutical Sciences. Remington's Pharmaceutical Sciences is a Handbook used to practice the pharmaceutical sciences, and is a guide to the professional responsibilities of the pharmacist teaching how to prepare various forms of compositions and storing the compositions. Thus it is an analogous art.

The rejection of Claim 47 under 35 U.S.C. 103(a) as being unpatentable over Kurginski (GB 1 279 148) as applied to claims 32, 34, 37, 40, 41, 42, 45, 54-56 above, in view of Root et al. (Antimicrobial Agents and Chemotherapy. Nov. 1988, pages 1627- 1631) is MAINTAINED.